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Brooklyn, NY 11210

EXAMINER
KIM, PAUL

ART UNIT	PAPER NUMBER
2161	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,940

Applicant(s)

BRANHAM ET AL.

Examiner

Paul Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

1. This Office Action is responsive to the following communication: Original Application filed on 9 April 2004.
2. Claims 1-15 are pending and present for examination. Claim 1 is independent.

Specification

3. The abstract of the disclosure is objected to because of undue length (i.e. exceeds 150 words). Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. **As per independent claim 1**, it is unclear whether the intermediate host server must comprise of all the sub-components. Additionally, it is unclear whether the website management module must inclusively comprise of all the interfaces, modules, and sub-components.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
8. **Claim 1** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 simply presents the components (e.g. server, modules, and interfaces) which comprise the subscription managing and transferring system. Specifically, the claims are not

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directed to the performance or execution of a process which allows for a tangible result. See State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. MPEP 2106. "The claimed invention as a whole must accomplish a practical application. That is, it must produce a 'useful, concrete and tangible result' " (emphasis added).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1-3 and 12** are rejected under 35 U.S.C. 102(e) as being anticipated by Gernold (USPGPUB No. 2004/0254885, hereinafter referred to as GERNOLD), filed on 24 February 2004, and published on 16 December 2004.

11. **As per independent claim 1**, GERNOLD teaches:

A subscription managing and transferring system accessible by publishers and end users, comprising:

An internet accessible intermediate host server, comprising:

At least one storage facility module adapted to contain information about specific publications that each end user has individually registered for {See GERNOLD, Figure 1; and [0023], wherein this reads over "[t]he data distribution process 180 uses the subscriptions 182 stored in the data storage device 140 to determined to which computer systems 115 and/or 120 each particular data modification should be sent"};

A publication module coupled with the storage facility module {See GERNOLD, Figure 1};

A tracking/reports module communicatively coupled to at least one storage facility module {See GERNOLD, Figure 1; and [0023], wherein this reads over "[s]ubscriptions 182 for a publication (that is, a particular type of data) to be sent are generated, based on application data 150, by the subscription generator 125"}.

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A user application used by subscribers to connect to the intermediate host server in order to determine if new publications have been submitted by publishers who the subscriber has registered for, register for new publications, unsubscribe from publishers and manage activities related to the specified users account {See GERNOLD, [0020], wherein this reads over "[t]he centralized computer system 110 has a centralized data repository that includes application data 150 used by all users of all computer systems 110, 115 or 120 that operate the application. The application data 150 may be stored in a centralized data repository"}.

At least one website management module on the intermediate host server communicatively coupled to at least one of the storage facility module or the application, wherein the website management module comprises:

A template based publication creation interface {See GERNOLD, [0052], wherein this reads over "[t]he subscription generator 425 includes an association 425A to a particular publication of publications 427 and a distribution criteria"};

A template based publication management interface {See GERNOLD, [0052], wherein this reads over "[t]he subscription generator 425 includes an association 425A to a particular publication of publications 427 and a distribution criteria"};

A tracking/reports-checking interface {See GERNOLD, [0052], wherein this reads over "a distribution criteria 425B that defines the basis upon which the type of data identified by the associated publication is to be distributed"};

At least one storage facility connection module {See GERNOLD, Figures 1 and 4};

At least one user application connection module {See GERNOLD, Figures 1 and 4};

An Internet connection between the host server and the Internet {See GERNOLD, [0052], wherein this reads over "[t]he centralized CRM system 410 also includes an online client 429 through which a user is able to access the CRM application program"}.

A storage facility module communicatively coupled to at least the one of the website module, the tracking module, the campaign module, or the user application, wherein the storage facility module comprises:

A plurality of devices and applications for storing publisher information, the location of publications submitted by a publisher, application user information, and application user tracking statistics {See GERNOLD, Figure 1; and [0019], wherein this reads over "[e]ach of the data storage devices 140, 142, and 144 includes application data 150, 152, or 154 and executable instructions 160, 162, or 164 for an application program"}.

12. As per dependent claim 2, GERNOLD teaches:

The system of claim 1, wherein the internet accessible host server is configured to carry at least one sequence of instructions for accessing subscription information stored in a storage facility, wherein execution of the at least one sequence of instructions comprises:

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Supplying, to an application user, new publication information data elements that are attributes of at least one query by retrieving the information data elements directly from at least one storage facility that contains the information data elements {See GERNOLD, [0034], wherein this reads over "calculation logic may identify a database query and the results of the database query then are used to generated subscriptions"};

Retrieving the one or more information data elements directly from at least one Storage facility {See GERNOLD, [0021], wherein this reads over "multiple application entities, each of which has a collection of data attribute values. Each entity may be stored as a row in a relational database table, an object instance in an object- oriented database"; and [0023], wherein this reads over "[s]ubscriptions 182 for a publication (that is, a particular type of data) to be sent are generated, based on application data 150, by the subscription generator"};

Displaying data information elements directly in the users application {See GERNOLD, [0027], wherein this reads over "the graphical user interface may be referred to as a subscription agent"}.

13. **As per dependent claim 3, GERNOLD teaches:**

The system of claim 2, wherein the supplying to the user of the publication information data elements is performed by:

The application retrieving from the intermediate server over the network (Otherwise known as pull technology), data for only those attributes of the at least one query that is requested by the user {See GERNOLD, [0034], wherein this reads over "calculation logic may identify a database query and the results of the database query then are used to generated subscriptions"};

Retrieving the information data elements directly from the at least one storage facility {See GERNOLD, [0034], wherein this reads over "calculation logic may identify a database query and the results of the database query then are used to generated subscriptions"};

Providing the information data elements to a user over a user interface, wherein the user is connected to the server computer over the network {See GERNOLD, Figure 1}.

14. **As per dependent claim 12, GERNOLD, in combination with BANERJEE, discloses:**

The system of claim 1, wherein the user application has the ability to maintain its own storage facility located on the users hardware device {See GERNOLD, Figures 1 and 4}.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. **Claims 4-5 and 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over GERNOLD, in view of Banerjee et al (USPGPUB No. 2003/0005133, hereinafter referred to as BANERJEE), filed on 28 June 2001, and published on 2 January 2003.

GERNOLD teaches the limitations of claims 1-3 and 12 for the reasons stated above.

GERNOLD differs from the claimed invention in that GERNOLD fails to specifically disclose and teach a system wherein an ID is randomly generated (claims 4-5).

GERNOLD differs from the claimed invention in that GERNOLD fails to specifically disclose and teach a system wherein the user application actively downloads publication information from the intermediate server (claims 13-14).

17. **As per dependent claim 4**, GERNOLD, in combination with BANERJEE, discloses:

The system of claim 3, wherein a single randomly generated ID is used to identify the application end user and in the determining of current publications submitted by publishers listed in the users subscription account {See BANERJEE, [0029], wherein this reads over "[a] subscriber database 14 contains records for each online subscriber including the online subscriber's identification . . . and the subscription expiration date"}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above invention suggested by GERNOLD, by combining it with the invention disclosed by BANERJEE. The results of this combination would lead to a system wherein a subscriber database would be used in providing an ID for the application end user and in determining the publications submitted by the publishers to which the user is subscribed.

One of ordinary skill in the art would have been motivated to do this modification in order to appropriately provide the user with the current and updated publications to which the user is subscribed.

18. **As per dependent claim 5**, GERNOLD, in combination with BANERJEE, discloses:

The system of claim 3, wherein a single randomly generated ID is used by at least one website module for tracking of publication viewing {See BANERJEE, [0029], wherein this reads over "[a] subscriber database 14 contains records for each online subscriber including the online subscriber's identification . . . and the subscription expiration date"}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above invention suggested by GERNOLD, by combining it with the invention

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disclosed by BANERJEE. The results of this combination would lead to a system wherein the ID is used in tracking the publication views.

One of ordinary skill in the art would have been motivated to do this modification in order to track which publications had been viewed by which users using the given IDs.

19. **As per dependent claim 13**, GERNOLD, in combination with BANERJEE, discloses:

The system of claim 12, wherein the user application connects to the website module and actively downloads the publication information from the intermediate server to be stored locally for display through the user application from the users hardware device {See BANERJEE, [0007], wherein this reads over "[o]nline subscriptions are delivered over the Internet to online subscribers who connect, with a browser, to a subscription server that downloads the subscription content to the online subscriber"}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above invention suggested by GERNOLD, by combining it with the invention disclosed by BANERJEE. The results of this combination would lead to a system wherein the publication information may be downloaded onto the users hardware device for display.

One of ordinary skill in the art would have been motivated to do this modification in order to access the publication information should the user no longer be able to access the intermediate server for the publication information.

20. **As per dependent claim 14**, GERNOLD, in combination with BANERJEE, discloses:

The system of claim 12, wherein the user application possesses the ability to connect to the intermediate server, access the publication locations, and download the publications directly to a location on the users hardware device for viewing at a later time {See BANERJEE, [0007], wherein this reads over "[t]he files downloaded from the subscription server contain all the information . . . required by the online subscriber's computer to display the same subscription content"}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above invention suggested by GERNOLD, by combining it with the invention disclosed by BANERJEE. The results of this combination would lead to a system wherein a user would be able to access the intermediate server and download the publication.

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One of ordinary skill in the art would have been motivated to do this modification in order to download the publication from the intermediate server such that the user may view the publication without having to be connected to the intermediate server.

21. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over GERNOLD, in view of Gerace et al (U.S. Patent No. 7,032,168, hereinafter referred to as GERACE), filed on 27 November 2001, and issued on 18 April 2006.

GERNOLD teaches the limitations of claims 1-3 and 12 for the reasons stated above.

GERNOLD differs from the claimed invention in that GERNOLD fails to specifically disclose and teach a system wherein links are provided to the end users representing the publications (claim 6).

22. **As per dependent claim 6**, GERNOLD, in combination with GERACE, discloses:

The system of claim 1, further comprising an active publication module communicatively coupled to at least one of the storage facility module, the tracking/reports module, the website management module or the application, wherein the active publication module comprises all stored publication and is adapted to extract information from at least one of the storage facility module and the tracking/reports module and manipulate the extracted information to provide links to the end users representing unviewed and previously viewed publications {See GERACE, C4:L18-30, wherein this reads over "[t]he search engine 29 processes the received queries . . . and searches the hyperlink database 30 for data that satisfies the queries and hence satisfies the request 26"}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above invention suggested by GERNOLD, by combining it with the invention disclosed by GERACE. The results of this combination would lead to a system wherein links representing the publications would be provided to the users.

One of ordinary skill in the art would have been motivated to do this modification such that the user may activate the links representing the publications and view the publications accordingly.

23. **Claims 7-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over GERNOLD, in view of GERACE, and in further view of Official Notice.

24. **As per dependent claim 7**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have stored publications comprise of at least one hyperlink, connecting

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the subscriber to the publication, since it was widely known at the time to use hyperlinks in accessing various resources (e.g. publications, articles, data) over the Internet.

25. **As per dependent claim 8**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display the hyperlink on a display screen such that the user may "activate" the hyperlink and allow the resource (i.e. the publication) to be displayed accordingly on the display screen.

26. **As per dependent claim 9**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the use of cookies to determine whether the publication had been previously viewed.

27. **As per dependent claim 10**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to update the storage facility to reflect that the publication was either viewed for the first initial time or for a repeated time, such that the statistics may be used when applying the expiration date.

28. **As per dependent claim 11**, GERNOLD, in combination with GERACE and Official Notice, discloses:

The system of claim 7, wherein after website module updates the storage facility to reflect viewing statistics, the at least one website module then accesses at least one storage facility to determine the location of the publication and then direct the user to that location {See GERACE, C4:L18-30, wherein this reads over "[t]he search engine 29 processes the received queries . . . and searches the hyperlink database 30 for data that satisfies the queries and hence satisfies the request 26"}.

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to update certain viewing statistics in the storage facility in either in data structures such as a database, logs, or cookies.

29. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over GERNOLD, in view of BANERJEE, and in further view of McBrearty et al (U.S. Patent No. 6,978,284, hereinafter referred to as McBREARTY), filed on 21 March 2002, and issued on 20 December 2005.

GERNOLD teaches the limitations of claims 1-3 and 12 for the reasons stated above.

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GERNOLD differs from the claimed invention in that GERNOLD fails to specifically disclose and teach a system wherein the expiration dates of publications are determined and expired publications are deleted from the users hardware device (claim 15).

30. **As per dependent claim 15**, GERNOLD, in combination with BANERJEE and McBREARTY, discloses:

The system of claim 12, wherein the user application connects directly to the intermediate server to determine the expiration date of all relevant publications {See BANERJEE, [0029], wherein this reads over "[t]hese records include the non-renewal subscriber's identification, the non-renewal subscriber's expiration condition"} at which time it deletes expired publications from the location on the users hardware device {See McBREARTY, Abstract, wherein this reads over "[i]f the earliest expiration date is earlier than the system date then a comparison is made with the files in the directory and individual files with expiration dates earlier than the current date are deleted"}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above invention suggested by GERNOLD, by combining it with the invention disclosed by BANERJEE and McBREARTY. The results of this combination would lead to a system wherein files with expiration dates earlier than a certain threshold are deleted.

One of ordinary skill in the art would have been motivated to do this modification such that the storage device is efficiently purged of out-dated and expired publications.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is (571) 272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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